

ESTTA Tracking number: **ESTTA1173581**

Filing date: **11/19/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Francelina M. Perdomo		
Entity	Individual	Citizenship	UNITED STATES
Address	845 THIRD AVE. 5TH FLOOR NEW YORK, NY 10022 UNITED STATES		

Correspondence information	FRANCELINE M. PERDOMO 845 THIRD AVE. 5TH FLOOR NEW YORK, NY 10022 UNITED STATES Primary Email: fmp@gdblawn.com Secondary Email(s): aatarpan@gmail.com No phone number provided.
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Registration Subject to Cancellation

Registration No.	5314041	Registration date	10/17/2017
Registrant	Counsel for Creators LLP 2000 RIVERSIDE DRIVE LOS ANGELES, CA 90039 UNITED STATES		

Goods/Services Subject to Cancellation

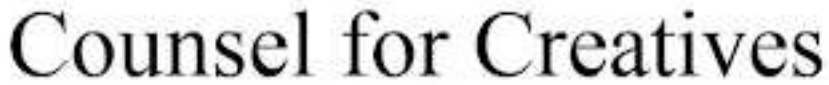
Class 045. First Use: 2013/04/30 First Use In Commerce: 2013/04/30 All goods and services in the class are subject to cancellation, namely: Legal services; legal services, namely, licensing intellectual property, including copyrights, and trademarks; legal services, namely, intellectual property prosecution and protection; legal services, namely, business formation and operation; legal services, namely, contract drafting, review and negotiation

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	90351710	Application Date	12/01/2020
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	COUNSEL FOR CREATIVES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 045. First use: First Use: 2011/03/22 First Use In Commerce: 2011/03/22 Legal services, namely, consulting clients and representation of clients in the field of entertainment law and intellectual property matters, providing information in the field of entertainment and intellectual property law, and providing commentaries in the field of entertainment and intellectual property law via the internet		

Attachments	90351710#TMSN.png(bytes) Cancellation petition Counsel for Creatives 2021.pdf(168920 bytes)
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Signature	/Francelina M. Perdomo/
Name	Francelina M. Perdomo
Date	11/19/2021

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration:

Reg. No.: 5314041
Registrant Counsel for Creators, LLP
Filed: April 18, 2017
Issued: October 17, 2017
Mark: **COUNSEL FOR CREATORS**

FRANCELINE M. PERDOMO

Petitioner,

v.

COUNSEL FOR CREATORS, LLP

Registrant.

Cancellation No.:

Registration No.: 5314041

PETITION FOR CANCELLATION

Petitioner, FRANCELINE M. PERDOMO ("Petitioner" or "PERDOMO"), an owner of the mark Counsel for Creatives, who will be damaged by the continued registration of COUNSEL FOR CREATORS as a trademark in International Class 045 for "legal services" as shown in Reg. No. 5314041 hereby petitions to cancel same under Count I as provided herein.

To the best of Petitioner's knowledge, the name and address of Registrant is as follows:

Counsel for Creators LLP
2000 Riverside Drive
Los Angeles, CA 90039

As grounds in support of the petition for cancellation, Petitioner asserts as follows:

1. Registrant, Counsel for Creators, LLP ("Registrant"), was awarded U.S. Registration No. 5314041 for COUNSEL FOR CREATORS on October 17, 2017 ("the Registration"). The services covered by the Registration are "*legal services, namely, licensing intellectual property, including copyrights, and trademarks; legal services, namely, intellectual property prosecution and protection; legal services, namely, business formation and operation; legal services, namely, contract drafting, review and negotiation*" ("the Subject Services").

2. Registrant filed Application Serial No. 87416129 on April 18, 2017, which ultimately issued on October 17, 2017. In the application, which was filed under Section 1(a), Registrant, then Applicant, claimed that the COUNSEL FOR CREATORS mark had been in use for the Subject Services since at least as early as April 30, 2013.

3. Petitioner filed its Counsel for Creatives mark with the USPTO on December 1, 2020 (Application Serial No. 90351710 ("the pending Application") in International Class 045 for "*legal services, namely, consulting clients and representation of clients in the field of entertainment law and intellectual property matters, providing information in the field of entertainment and intellectual property law, and providing commentaries in the field of entertainment and intellectual property law via the internet.*"

4. In the pending Application, Petitioner pointed out that the mark COUNSELS FOR CREATIVES has been in use for the serviced cited in the pending Application since at least as early as March 22, 2011 about two (2) years prior to April

2013, when the Registrant allegedly started using its mark.

5. As a result of Registrant's registration, Petitioner's application has been rejected under Section 2(d). Petitioner shall file a response to the pending Office Action and request that the proceedings be suspended pending final resolution of the instant cancellation proceeding.

6. Petitioner has standing to file this Petition for Cancellation as Petitioner is being injured and will continue to be injured by the Registration as Petitioner is the party with priority to use the COUNSELS FOR CREATIVES mark or prevent the use of any other mark likely to cause confusion therewith (i.e. COUNSEL FOR CREATORS) and is competing for the same clients as Petitioner.

7. Based on the foregoing, Petitioner asserts the following grounds for the cancellation petition.

COUNT I - LIKELIHOOD OF CONFUSION

8. Petitioner incorporates by reference paragraphs 1-7 as if fully stated herein.

9. Since at least as early as March 22, 2011 Petitioner has been using the Counsel for Creatives mark in association with "*legal services, namely, consulting clients and representation of clients in the field of entertainment law and intellectual property matters, providing information in the field of entertainment and intellectual property law, and providing commentaries in the field of entertainment and intellectual property law via the internet*" and has provided services to domestic (including in the tristate area) and international clients under the mark. Additionally the Petitioner has developed and

maintained a Facebook page facebook.com/counsel4creatives featuring said services.

10. As a result of the widespread use in interstate commerce by Petitioner of the mark Counsel for Creatives, Petitioner has acquired extensive goodwill, has developed a high degree of distinctiveness and is well known and recognized as providing high quality legal services to its clients.

11. Petitioner filed its Counsel for Creatives mark with the USPTO on December 1, 2020, Application Serial No. 90351710 ("the pending Application") in International Class 045 for "*legal services, namely, consulting clients and representation of clients in the field of entertainment law and intellectual property matters, providing information in the field of entertainment and intellectual property law, and providing commentaries in the field of entertainment and intellectual property law via the internet*" and the Application has been initially rejected based on the contested Registration.

12. With her application Petitioner filed a statement of use predating any valid use by the Registrant of its COUNSEL FOR CREATORS mark.

13. Registrant's COUNSEL FOR CREATORS mark is confusingly similar to Petitioner's Counsel for Creatives mark, thus creating a likelihood of confusion among consumers.

14. Registrant's services ("*legal services; legal services, namely, licensing intellectual property, including copyrights, and trademarks; legal services, namely, intellectual property prosecution and protection; legal services, namely, business formation and operation; legal services, namely, contract drafting, review and*

negotiation”) are identical or nearly identical to Petitioner's services such that they would reach the relevant consumers through the same channels of trade and would be used by the same class of consumers, artists, inventors and individuals and businesses seeking to protect their intellectual property rights.

15. Registrant's use of the mark COUNSEL FOR CREATORS in connection with its list of services is likely to cause confusion, mistake, or deception as to the source or origin of Registrant's services in the public, the trade and others are likely to believe that Registrant's services are: (a) the same services as that of Petitioner's; or (b) provided by, sponsored by, approved by, licensed by, affiliated with or in some other way legitimately connected to Petitioner and/or its services.

16. If Registrant is permitted to maintain its Registration for the Subject Services, confusion within the relevant trade and public is likely to result, which will cause damage to Petitioner's business. Such belief of damages by Petitioner is reasonable under the circumstances.


17. Because Registrant has been granted a registration on the Supplemental Register, it has obtained a *prima facie* exclusive right to use the COUNSEL FOR CREATORS mark which will damage the Petitioner's business because Petitioner has been using the Counsel for Creatives mark in good faith in connection with her services for more than two (2) years prior to Registrant's claimed first use in commerce date.

18. Therefore, under Section 2(d), Registrant's use of the mark is likely to cause confusion with Petitioner's use of the mark Counsel for Creatives and because Petitioner has prior use of the mark, the Registration should be cancelled.

WHEREFORE, Petitioner requests that this Petition for Cancellation be sustained and that the Registration No. 5314041 be cancelled in all respects.

Dated this 19th day of November, 2021.

Respectfully submitted,

By:  _____

Francelina M. Perdomo

Petitioner